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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,215	02/09/2001	Omar M. Buazza	5040-04205	6988

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EXAMINER
HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
1722	12

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/780,215	BUAZZA ET AL.	
	Examiner	Art Unit	
	Donald Heckenberg	1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 January 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *293-310 and 443-474* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *293-310 and 443-474* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *9,11* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (Cust. & Pat. App. 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (Cust. & Pat. App. 1970);and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (Cust. & Pat. App. 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 293-310 and 443-474 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 366, and 383-399 of

copending Application No. 09/780,076 (hereinafter "App. '076") in view of Kachel et al. (US Pat. No. 4,895,102; previously of record).

Claims 366, and 383-399 of App. '076 recite an apparatus substantially as recited in claims 293-310 and 443-474 of the instant application. Additionally claim 366 of App. '076 recites a coating unit for applying a coating to the eyeglass lens during use.

Kachel teaches a lens forming apparatus in combination with a coating unit which applies abrasion resistant coatings to the formed eyeglass lenses (see column 8, ln. 38 - column 10, ln. 34).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus recited in claim 366 of the instant application as such to have added a coating unit because this would have allowed for coatings to be applied to the molded eyeglass lenses and therefore make the lenses more abrasion resistant as suggested by Kachel. Therefore, claims 393-310 and 443-474 of the instant application is obvious in view of claims 366, and 383-399 of App. '076.

This is a provisional obviousness-type double patenting rejection.

3. Claims 450-474 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1288-1320 of copending Application No. 09/789,000 (hereinafter "App. '000") in view of EP 0 318 164 (previously of record; hereinafter "EP '164").

Claims 1288-1320 of App. '000 recite an apparatus substantially as claimed in claims 450-474 of the instant application. Notably, claim 1288 recites a controller coupled to the lens curing unit to control the lens curing unit based on prescription information read off of the mold assembly. Claims 1288-1320 of App. '000 additionally recite a reader coupled to the lens curing unit configured to read the prescription information from the mold assembly, which is not recited in claims 450-474 of the instant application. However, EP '164 teaches an eyeglass lens curing apparatus with a reader which operates to read the prescription off of the mold assembly for the purpose of supplying the prescription information to the apparatus controller (see p. 14, line 6 - p. 17, line 12). Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the apparatus recited in claims 450-474 of the instant application to further comprise a reader coupled with the controller because this would allow for the controller to

operate the apparatus based on the prescription information provided on the mold assembly as suggested by EP '164. This is a provisional obviousness-type double patenting rejection.

4. Claims 450-474 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1204-1227 and 1288-1311 of copending Application No. 09/788,998 (hereinafter "App. '998") in view of EP '164.

Claims 1204-1227 and 1288-1311 of App. '998 recite an apparatus substantially as claimed in claims 450-474 of the instant application. Notably, claims 1204 and 1288 recite a controller coupled to the lens curing unit to control the lens curing unit based on prescription information read off of the mold assembly. Claim 1204 additionally recites a coating unit, and claim 1288 additionally recites a computer and software to operate the controller. EP '164 teaches an eyeglass lens curing apparatus further provided with a coating unit for the purpose of applying coatings to the eyeglass lenses (see p. 23, line 5 - p. 25, line 8), and a computer and software to operate the controller (p. 12, line 40 - p. 17 line 12). Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the apparatus

recited in claims 450-474 of the instant application to further comprise a coating unit and computer with software because this would have allowed coatings to be applied to the eyeglass lenses and control the apparatus operation as suggested by EP '164.

This is a provisional obviousness-type double patenting rejection.

5. Claims 450-474 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 09/789,195 (hereinafter "App. '195") in view of EP '164.

Claims 1289-1313 describe all of the limitations recited in claims 450-474 of the instant application. Notably, claims 1289 recites a controller coupled to the lens curing unit to control the lens curing unit based on prescription information read off of the mold assembly. Claims 1289-1313 also recite a mold filling apparatus. EP '164 teaches an eyeglass lens forming apparatus further provided with a mold filling apparatus for the purpose of dispensing a lens forming resin into the mold cavity. Therefore, It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus set forth in claims 450-474 of the instant application to further comprise a mold filling apparatus

because this would have allowed for a lens forming resin to be dispensed into the mold cavity as suggested by EP '164.

This is a provisional obviousness-type double patenting rejection.

6. Claim 450 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 274 of copending Application No. 10/188,261 (hereinafter "App. '261") in view of EP '164. (note, the preliminary amendment in App. '261 filed on June 3, 2002, is improperly numbered, the claim numbered 373 in the preliminary amendment in App. '261 has been renumbered as 274 pursuant to 37 CFR 1.126).

Claim 274 of App. "261" recites an apparatus as substantially recited in claim 450 of the instant application. Notably, claim 274 recites a programmable controller configured to substantially control operation of the lens curing unit wherein the controller is configured to control operation of the lens curing unit as a function of eyeglass prescription. Claim 450 of the instant application additionally recites the mold assembly to comprise a mold assembly identification wherein the controller is configured to determine the identification marking. EP '164 teaches the use of identification markings on

mold assemblies containing prescription information for the purpose of working in combination with the controller of the lens curing unit. Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the apparatus recited in claim 272 of App. '261 as such to have provided a mold assembly marking containing prescription information because this would have allowed for operation of the apparatus controller based on the identification marking as suggested by EP '164.

This is a provisional obviousness-type double patenting rejection.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 293-297 and 299-310, and 443-450 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '164 in view of Blum et al. (US Pat. No. 4,919,850; previously of record).

EP '164 substantially teaches the apparatus as claimed. As a more specific representation, EP '164 teaches a lens forming apparatus comprising a front mold member (28) having a casting

face, a non-casting face, and a front mold identification marking (see p. 4, lns. 35-36), a back mold member (28) having a casting face, a non-casting face and a back mold identification mark (see p. 4, lns. 35-36), the back mold member being spaced apart from the front mold member by a gasket (30) during use, the gasket comprising a gasket identification marking (see p. 4, lns. 35-36), wherein the casting faces of the front mold member and the back mold member and an inner surface of the gasket at least partially define a mold cavity (40) which defines the shape corresponding to an eyeglass prescription, a coating unit (20) for applying a coating to the eyeglass lens during use, and a controller comprising an input device for obtaining information form an user, and an output device for transmitting information to the user, wherein the controller is configured to determine the front mold identification marking, the back mold identification marking, and the gasket identification marking in response to the eyeglass prescription being entered through the input device, and wherein the controller is configured to transmit via the output device the front mold identification marking, the back mold identification marking, and gasket identification marking, and wherein the controller is configured to control the operation of the apparatus during use (see p. 12, ln. 40 - p. 17, ln. 12).

EP '164 teaches the use of heating ovens to cure the lens molding material (p. 12, lns. 29-35), but fails to teach the lens curing unit to be configured to direct activating light toward the mold members during use in order to cure the lens molding material.

EP '164 also fails to teach the lens curing unit to comprise a first light source and a second light source, wherein the controller is configured to individually control the first and second light sources of the lens curing unit.

Blum teaches an apparatus for molding plastic eyeglass lenses which uses ultra-violet light to cure the molding material. Blum notes that UV curing is advantageous to thermal curing because UV curing is much faster (col. 1, lns. 30-55).

Blum further teaches the apparatus to comprise two sets of UV light curing sources (102 and 104) independently controlled by controller in order to tailor the resulting curing to a particular molding material (see col. 6, lns. 37-64).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of EP '164 as such to have used a lens curing unit configured to direct activating ultra-violet light towards the mold members during use because this would speed up the molding process as suggested by Blum.

It also would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of EP '164 as such to have the lens curing unit comprise two light sources independently controlled by a controller because this would have allowed the apparatus to be configured to optimally cure particular molding materials as suggested by Blum.

11. Claims 298 and 463 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '164 modified by Blum as applied to claims 293-297 and 299-310 above, and further in view of Buazza et al. (US Pat. No. 6,086,799; previously of record).

EP '164 and Blum teach the apparatus as described above. EP '164 and Blum fail to teach the apparatus to further comprise a light sensor configured to measure the dose of light transmitted to the mold cavity, wherein the light sensor is configured to communicate with the controller, and wherein the controller varies the intensity or duration of light such that a predetermined dose is transmitted to the mold cavity.

Buazza teaches a lens molding apparatus comprising a light sensor configured to measure the dose of light transmitted to the mold cavity and wherein the light sensor is configured to communicate with the controller, and wherein the controller

varies the intensity or duration of light such that a predetermined dose is transmitted to the mold cavity (col 45, ln. 56 - col. 46, ln. 9).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of EP '164 and Blum as such to have lens molding apparatus further comprise a light sensor working in conjunction with a controller because this would have allowed to the lens to be optimally cured with predetermined doses of light as suggested by Buazza.

12. Claims 450-470 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '164 in view of Buazza et al. (US Pat. No. 6,022,498; previously of record).

EP '164 teaches the apparatus substantially as claimed. More specifically, EP '164 teaches a lens forming apparatus and programmable controller (see p. 17, line 26 - p. 26, line 3). EP '164 teaches the mold assemblies comprising first and second mold members, and gasket members, wherein the various parts of the mold assembly are provided with identification markings (see p. 10, line 3 - p. 17, line 12). EP '164 further teaches the controller to be configured to determine the identification marking(s) and control apparatus operation (see p.10, line 3 -

p.17, line 12). EP '164 further teaches the apparatus to comprise a lens curing unit. EP '164 further teaches the general controller operation recited in the dependent claims of the instant application (see figures 17A - 17R, and p. 17, line 25 - p.28, line 15).

EP '164 fails to teach the lens curing unit to deliver activating light, and the controller to control operation of such an activating light curing unit.

Buazza teaches a lens curing unit with light filters and a heating system (figures 2-6). Buazza teaches the lens curing unit to provided with a controller which operates on the curing unit to direct the activating light as to cure light activated lens forming composition placed in mold assemblies (see for example, column 5, lines 45-58).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of EP '164 as such to have the lens curing unit to direct activating light towards the mold assemblies during use as disclosed by Buazza, and further have the controller operate the activating light lens curing unit because this would allow for the use of activating light to cure a light curable lens forming composition.

13. Applicant's arguments filed January 9, 2003 have been fully considered but they are not persuasive.

With respect to the double-patenting rejection in view of co-pending application 09/780,076, Applicant asserts that the double patenting rejection is incorrect. However, Applicant fails to set forth any reason why the double patenting rejection is incorrect, and is thus non-responsive to the double patenting rejection. See 37 CFR 1.111(b). Applicant therefore has apparently acquiesced to the correctness of this double patenting rejection.

Applicant points out the features of the claimed invention not taught by EP '164, and the features of the claimed invention not taught by Blum, and concludes that the combination is not taught by the prior art.

One cannot show non-obviousness by attacking references individually where the rejections are based on a combination of references. In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); In re Keller, 642 F.2d 413, 208 USPQ 871 (Cust. & Pat. App. 1981). The test of obviousness is not express suggestion of the claimed invention in any or all of the references, but rather what the references taken collectively would suggest to those of ordinary skill in the art presumed to

be familiar with them. In re Rosselet, 347 F.2d 847, 146 USPQ 183 (Cust. & Pat. App. 1965). Applicant's arguments directed to the features not taught by EP '164 and the features not taught by Blum are a piecemeal analysis of the references, that cannot be used to overcome a rejection under 35 U.S.C. 103.

Applicant argues that that there is no suggestion to combine the features taught by EP '164 and Blum. This argument ignores the advantages, and hence motivation to combine EP '164 and Blum described in the previous Office Action and repeated above.

Applicant further argues that hindsight construction is required to combine the features of EP '164 and Blum.

It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (Cust. & Pat. App. 1971). In the instant case, the primary reference of EP '164 teaches the features as described in the previous Office Action and repeated above. Blum teaches the features not taught by EP '164, and further discloses the

advantage of these features as described in the previous Office Action and repeated above, and thus provide motivation to modify the primary reference. Therefore, the references render obvious to one of ordinary skill in the art all the features of the claimed invention as described in the previous Office Action and repeated above.

Applicant separately argues that every rejected dependent claim is also patentable based on the subject matter recited in the claim. Applicant's response recites the features in every dependent claim, and states that each feature is not taught or suggested by the prior art.

Applicant's arguments to each of these rejected dependent claims are general allegations of patentability, and thus, non-responsive to the claims individually. See 37 CFR 1.111(b). However, all of the features of the dependent claims are taught or suggested by the prior art as described in the previous Office Action and repeated above.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (703) 308-0457. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for responses to non-final action,

and 703-872-9311 for responses to final actions. The unofficial fax phone number is (703) 305-3602.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Donald Heckenberg
March 17, 2003

JAMES P. MACKEY
PRIMARY EXAMINER
3/19/03